

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHLOMO BEN-HAIM, URI YARON  
and AVRAHAM MATCOVITCH

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Appeal 2007-2143  
Application 09/379,540<sup>1</sup>  
Technology Center 3600

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Decided: 24 July 2007

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Before SALLY GARDNER LANE, SALLY C. MEDLEY, and MICHAEL  
P. TIERNEY, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION ON APPEAL

1           **A. Statement of the Case**

2           Applicants appeal under 35 U.S.C. § 134 from a final rejection of  
3           claims 1-40. We have jurisdiction under 35 U.S.C. § 6(b).

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1   Application for patent filed 24 August 1999. The real party in interest is Biosense, Inc.

Appeal 2007-2143  
Application 09/379,540

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ponzi	US 6,027,473	Feb. 22, 2000
German	US 6,258,789	Jul. 10, 2001
Flaherty	US 6,283,951	Sep. 4, 2001
Ben-Haim (Ben-Haim '109)	US 6,321,109	Nov. 20, 2001
Ben-Haim (Ben-Haim '370)	US 6,309,370	Oct. 30, 2001

Claim 1 stands rejected under the judicially created doctrine of double patenting over claim 1 of Ben-Haim '370 (Final Rejection 2 and Answer 3).

Claims 1-18 and 25-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ben-Haim '109 in view of Flaherty (Final Rejection 3 and Answer 3).

Claims 1-18 and 25-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponzi in view of Flaherty (Final Rejection 4 and Answer 3).

Claims 19-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Ben-Haim '109 or Ponzi in view of Flaherty and German (Final Rejection 6 and Answer 3).

1           **B. Findings of fact (“FF”)**

2           The record supports the following findings of fact as well as any other  
3 findings of fact set forth in this opinion by at least a preponderance of the  
4 evidence.

5           1. Applicants’ claims 1-40 are the subject of this appeal.

6           2. Claim 1, the sole independent claim is as follows:

7                   1. A method for inducing angiogenesis or myogenesis in a  
8 heart of a patient comprising the steps of:

9                           providing a system for intracardiac drug administration  
10 comprising a catheter, said catheter having at least one position sensor  
11 which generates signals responsive to an applied field for determining  
12 the position and orientation of said catheter, said signals being used to  
13 generate position and orientation coordinates, and a drug delivery  
14 device for delivering said cell, the system also comprising control  
15 circuitry for determining position and orientation coordinates of a  
16 distal end of said catheter and for generating a viability map of said  
17 heart comprising a site suitable for targeted therapy by said catheter;  
18                           generating the viability map of the heart;  
19                           identifying said site suitable for targeted therapy on said  
20 viability map;  
21                           inserting said catheter into a chamber of said heart at said site;  
22                           delivering said cell to said site with said drug delivery device  
23 based on position and orientation coordinates in response to said

1 signals from said position sensor, and inducing angiogenesis or  
2 myogenesis in said site of said heart from said delivered cell.

3 Ben-Haim '370

4 3. The involved application is said to be a continuation-in-part of  
5 Ben-Haim '370 (Specification 1:4-5).

6 4. Ben-Haim '370 issued 30 October 2001, based on application  
7 09/019,453, filed 5 February 1998.

8 5. In response to the obviousness-type double patenting rejection,  
9 Applicants argued in the Appeal Brief that a terminal disclaimer had been  
10 faxed to the Office on 5 May 2003 (Appeal Br. 5).

11 6. Applicants attached a copy of the 5 May 2003 fax to the Appeal  
12 Brief, and labeled it "Attachment 1."

13 7. The Examiner maintained the rejection and argued that:

14 Applicant has not officially filed a terminal disclaimer, he has  
15 only provided the office with a copy of a terminal disclaimer.  
16 Applicant must officially provide the office with a terminal  
17 disclaimer and pay the proper fees (Answer 2).  
18

19 8. Applicants submitted another terminal disclaimer in response to the  
20 Examiner's Answer ("Terminal Disclaimer" 11 March 2004 and Reply 2).

21 9. The terminal disclaimer was apparently approved by the Office  
22 ("Terminal Disclaimer Approval form used within the USPTO", 14 March  
23 2004).  
24  
25

1        Ben-Haim '109

2        10. Ben-Haim '109 issued 20 November 2001, based on application  
3        09/117,804, filed 29 December 1998.

4        11. Application 09/117,804 was published 14 June 2001 as  
5        publication number 2001-003790.

6        12. The Ben-Haim application was filed based on § 371  
7        PCT/IL97/00059, which has a filing date of 14 February 1997.

8        13. The PCT application was published 21 August 1997  
9        (WO97/29701).

10       14. The Ben-Haim '109 patent § 102(e) date is said to be "Dec. 29,  
11       1998" (Ben-Haim '109 front page).

12       15. Applicants argue that Ben-Haim '109 is not prior art to it, since  
13       (1) the reference has a 102(e) date that is after the priority date of the  
14       involved application, and (2) the reference and the application were  
15       commonly owned at the time of the invention (Appeal Br. 5-6).

16       16. The Examiner responded and found that Ben-Haim '109<sup>2</sup> is (1)  
17       also available as a 102(a) reference and (2) based on an application filed  
18       prior to November 29, 1999, such that the subject matter that is disqualified  
19       as prior art under 103(c) is limited to subject matter that qualifies as prior art  
20       only under 102(f) or 102(g) (Answer 4).

21

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<sup>2</sup> The Examiner's reference to Ben-Haim 6309370 is believed to be in error.  
See Reply Br. 2 and Examiner's response (30 June 2004), merely noting the

1           Ponzi

2           17. Ponzi issued 22 February 2000, based on application 08/924,341,  
3           filed 5 September 1997.

4           18. Applicants argue that Ponzi is not prior art to it, since the  
5           reference and the application were commonly owned or assigned<sup>3</sup> at the time  
6           of the invention (Appeal Br. 8-9).

7           19. The Examiner argued that Ponzi is (1) available as a 102(a)  
8           reference and (2) based on an application filed prior to November 29, 1999,  
9           such that the subject matter that is disqualified as prior art under 103(c) is  
10          limited to subject matter that qualifies as prior art only under 102(f) or  
11          102(g) (Answer 5).

12           **D. Principles of Law**

13                                   35 U.S.C. § 103

14          A patent may not be obtained though the invention is not identically  
15          disclosed or described as set forth in section 102 of this title, if the  
16          differences between the subject matter sought to be patented and the prior art  
17          are such that the subject matter as a whole would have been obvious at the  
18          time the invention was made to a person having ordinary skill in the art to  
19          which said subject matter pertains. 35 USC § 103(a).

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reply brief.

<sup>3</sup> A copy of the recorded assignment for Ponzi is attached to the Appeal Br. (Attachment 3).



1           As of the date of this decision, 35 USC § 103(c)(1) is as follows:

2           Subject matter developed by another person, which qualifies as prior  
3 art only under one or more of subsections (e), (f), and (g) of section 102 of  
4 this title, shall not preclude patentability under this section where the subject  
5 matter and the claimed invention were, at the time the invention was made,  
6 owned by the same person or subject to an obligation of assignment to the  
7 same person.

8           As of the date of this decision, 35 USC § 103(c)(2) and (c)(3) are as  
9 follows:

10          (2) For purposes of this subsection, subject matter developed by  
11 another person and a claimed invention shall be deemed to have been owned  
12 by the same person or subject to an obligation of assignment to the same  
13 person if —

14          (A) the claimed invention was made by or on behalf of parties to a  
15 joint research agreement that was in effect on or before the date the  
16 claimed invention was made;

17          (B) the claimed invention was made as a result of activities  
18 undertaken within the scope of the joint research agreement; and

19          (C) the application for patent for the claimed invention discloses or is  
20 amended to disclose the names of the parties to the joint research  
21 agreement.

22          (3) For purposes of paragraph (2), the term “joint research  
23 agreement” means a written contract, grant, or cooperative agreement



1 entered into by two or more persons or entities for the performance of  
2 experimental, developmental, or research work in the field of the claimed  
3 invention.

4 **E. Analysis**

5 *The nonstatutory double patenting rejection*

6 In response to the Examiner's Final Rejection and arguments made in  
7 the Answer, Applicants submitted a terminal disclaimer (FF 8). The Office  
8 apparently accepted and approved of the subsequently filed terminal  
9 disclaimer (FF 9).

10 In response, the Examiner did not withdraw the rejection or indicate  
11 why, based on the events that occurred after the Examiner's Answer was  
12 made, the rejection has merit. Based on the record before us, Applicants  
13 filed a terminal disclaimer that has apparently been approved by the Office.  
14 The Examiner is silent as to why the Office's apparent acceptance and  
15 approval is in error. Accordingly, the rejection of claim 1 based on the  
16 nonstatutory double patenting rejection is reversed.

17 *The obviousness rejection of all claims based on Ben-Haim '109*

18 The Examiner finally rejected claims 1-18 and 25-40 based on Ben-  
19 Haim '109 in view of Flaherty. The Examiner finally rejected claims 19-24  
20 based on Ben-Haim, Flaherty and German. A prior art reference relied on in  
21 the context of a 103 rejection must qualify as 102 prior art. For example, a  
22 reference relied on by the Examiner in an obviousness rejection must  
23 comply with the date requirements set forth under 35 U.S.C. § 102.

1           At issue is whether the Ben-Haim '109 reference qualifies as "prior  
2 art," e.g., whether the Ben-Haim '109 reference complies with one of the  
3 102 date requirements. Applicants argue that Ben-Haim '109 does not  
4 qualify under 102(e) as a reference to it, since the 29 December 1998  
5 "102(e)" Ben-Haim '109 date is after Applicants' 5 February 1998 priority  
6 date. In addition, Applicants argue that if it is determined that Ben-Haim  
7 '109 does qualify as 102(e) art, that Applicants can overcome the reference  
8 since Ben-Haim '109 and the application, at the time of the invention, were  
9 commonly owned (FF 15). As to the issue presented, all of the claims stand  
10 or fall together.

11           If Ben-Haim '109 does not qualify as 102(e) prior art, e.g., the Ben-  
12 Haim '109 date is no good, then there is no need to consider the arguments  
13 made as to whether Ben-Haim '109 and the application were commonly  
14 owned at the time the invention was made.

15           The Examiner fails to respond to Applicants' argument that Ben-Haim  
16 '109 fails to qualify as 102(e) art. Based on the record, we cannot sustain  
17 the rejection made by the Examiner to the extent that the Examiner found  
18 Ben-Haim '109 to qualify as 102(e) art. The Ben-Haim '109 "102(e)" date  
19 listed on the front page is after Applicants' 5 February 1998 effective filing  
20 date (FF 14). We further note that Applicants contend that they have been  
21 properly granted priority of Ben-Haim '370 (FF 15). The Examiner  
22 apparently agrees that Applicants are entitled to the earlier parent date  
23 (Answer 3, ¶ 11).

1       The Examiner alternatively found that Ben-Haim '109 qualifies as  
2   102(a) prior art (FF 16). The Examiner first presented this finding in the  
3   Answer. The Examiner does not explain in any way how Ben-Haim '109  
4   qualifies as 102(a) prior art. The provisions of 102(a) are as follows:

5       “A person shall be entitled to a patent unless .....the invention  
6       was known or used by others in this country, or patented or  
7       described in a printed publication in this or a foreign country,  
8       before the invention thereof by applicant for patent” 35 USC §  
9       102(a).

10  
11       The Ben-Haim '109 14 June 2001 publication date (US Pub.  
12   2001003790) is after Applicants' 24 August 1999 application filing date and  
13   the application's 5 February 1998 effective filing date. The Ben-Haim '109  
14   20 November 2001 issue date is after the 24 August 1999 application filing  
15   date and the 5 February 1998 effective filing date. Thus, Ben-Haim (either  
16   the patent or publication) apparently fails to qualify as 102(a) prior art.  
17   Based on the record the Examiner has failed to explain otherwise. To the  
18   extent the Examiner is somehow relying on the earlier published PCT  
19   W097/29701 (said to be published 21 August 1997) listed on the front of the  
20   Ben-Haim '109 patent, that position has not been articulated. Moreover, if  
21   the Examiner were to rely on PCT W097/29701 as a 102(a) reference, then  
22   the Examiner would need to (1) make clear that the rejection is based on the  
23   PCT reference and not Ben-Haim '109, (2) make the reference of record, and  
24   (3) and explain how the reference would apply to the claims. We will not  
25   independently review the PCT publication prior to the Examiner having

1 made the rejection based on the PCT publication. We further note, that  
2 during prosecution and according to the official IFW record, the Examiner  
3 on two occasions failed to consider the reference PCT W097/29701 (August  
4 24, 1999 – List of references cited by the applicant and considered by the  
5 examiner and October 25, 2002, List of references cited by the applicant and  
6 considered by the examiner). Therefore, according to the official record it is  
7 not even apparent that the Examiner ever considered PCT W097/29701.

8 For these reasons, we cannot sustain the rejections made by the  
9 Examiner to the extent that the Examiner found Ben-Haim '109 to qualify as  
10 102(a) art.

11 For all of these reasons, the rejections of all claims made on the basis  
12 of Ben-Haim '109 are reversed.

13 *The obviousness rejection of all claims based on Ponzi*

14 The Examiner rejected claims 1-18 and 25-40 based on Ponzi in view  
15 of Flaherty. The Examiner rejected claims 19-24 based on Ponzi, Flaherty  
16 and German. Applicants maintain that the Ponzi reference cannot be applied  
17 against it, since Ponzi and Applicants' application were commonly assigned  
18 or obligated to an assignment at the time the invention was made (FF 18). In  
19 support of the assertion made as to the common assignment, Applicants  
20 presented evidence (Appeal Brief Attachment 3). As to this issue, all of the  
21 claims stand or fall together.

22 The Examiner found that a rejection based on 102(e) cannot be  
23 overcome by asserting common assignation. The Examiner alternatively

1 found that Ponzi qualifies as 102(a) prior art (FF 19). Both findings were  
2 first presented in the Answer. The Examiner does not explain in any way  
3 how Ponzi qualifies as 102(a) prior art.

4 The Ponzi 22 February 2000 issue date is after the 24 August 1999  
5 application filing date and the application 5 February 1998 effective filing  
6 date. The Ponzi application that matured into “Ponzi” was apparently never  
7 published. Therefore, we do not know, nor does the Examiner explain how  
8 Ponzi qualifies as 102(a) prior art. For these reasons, we cannot sustain the  
9 rejection made by the Examiner to the extent that the Examiner found Ponzi  
10 to qualify as 102(a) art.

11 Subsequent to the Brief, Answer, and Reply Brief the provisions of 35  
12 U.S.C. 103(c) were amended under the Cooperative Research and  
13 Technology Enhancement Act of 2004 (CREATE Act). Section 103(c) now  
14 consists of three parts – 103(c)(1), (c)(2) and (c)(3). The current 103(c)  
15 statutory section does allow an applicant to overcome a 103(a) rejection  
16 when the art qualifies under 102(e). The new 103(c) applies to all  
17 applications pending on or after December 10, 2004. MPEP 2146 (8th ed.,  
18 Rev. 5, Aug. 2006).

19 At the time the Examiner considered Applicants’ common assignment  
20 arguments, it is clear that the Examiner did not consider the evidence  
21 presented or arguments made. The Examiner was under the impression that  
22 it was not necessary to do so (FF 19). Since the turn of events, it is clear  
23 now that the Examiner must consider the Applicants’ arguments and

1 evidence on the merits. That is the Examiner must consider whether the  
2 Applicants' arguments and evidence presented overcome the rejection under  
3 103(c). Since the Examiner has not reviewed or considered such arguments  
4 and evidence in the first instance, the issue is not ripe for our review.  
5 Accordingly, we remand the Application back to the Examiner for  
6 consideration of such arguments and evidence.

7 **E. Decision**

8 Upon consideration of the record, and for the reasons given, the  
9 Examiner's rejection of claim 1 under the judicially created doctrine of  
10 double patenting over claim 1 of Ben-Haim '370 is reversed.

11 The Examiner's rejection of claims 1-18 and 25-40 under 35 U.S.C. §  
12 103(a) as being unpatentable over Ben-Haim '109 in view of Flaherty is  
13 reversed.

14 The Examiner's rejection of claims 19-24 under 35 U.S.C. § 103(a) as  
15 being unpatentable over Ben-Haim '109, Flaherty and German is reversed.

16 The Examiner's rejection of claims 1-18 and 25-40 under 35 U.S.C. §  
17 103(a) as being unpatentable over Ponzi in view of Flaherty on the basis that  
18 Ponzi qualifies as a reference under 35 U.S.C. § 102(a) is reversed.

19 The Examiner's rejection of claims 19-24 under 35 U.S.C. § 103(a) as  
20 being unpatentable over Ponzi, Flaherty, and German on the basis that Ponzi  
21 qualifies as a reference under 35 U.S.C. § 102(a) is reversed.

22 The case is further remanded to the Examiner to consider the  
23 Applicants' arguments and evidence of record regarding whether Ponzi

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1 precludes patentability under 103(c)(1). In addition, the Examiner may  
2 consider any arguments or evidence subsequently made by Applicants as to  
3 whether Ponzi precludes patentability under 103(c)(2) and (c)(3).

4       This application, by virtue of its “special” status, requires an  
5 immediate action. MPEP 708.01 (8th ed., Rev. 5, Aug. 2006). It is  
6 important that the Board be informed promptly of any action affecting the  
7 appeal in this proceeding.

REVERSED AND REMANDED

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